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Reply
Brief
(2)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s): Weadock et al.

Examiner: P. Prebilic

Serial No.: 09/391,762

Group Art Unit: 3738

Filed: September 8, 1999

Docket: 498-36 RES

For: TUBULAR EXPANDED
POLYTETRAFLUOROETHYLENE
IMPLANTABLE PROSTHESES

Dated: May 7, 2002

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Date: May 7, 2002

Signature: Barbara Kemmlein

Commissioner for Patents
Washington, D.C. 20231

REPLY BRIEF PURSUANT TO 37 C.F.R. §1.193(b)(1)

Sir:

In response to the Examiner's Answer mailed on March 13, 2002, a reply to which is due May 13, 2002, please consider the following remarks.

REMARKS

In Appellant's Brief on Appeal, the Appellant argues that the present claims do not constitute impermissible recapture of surrendered subject matter. Claim 13 has been narrowed in certain aspects so that claim 13 is sufficiently distinct from patent claim 1 in order to avoid recapture of surrendered subject matter.

Considered
PP
6/17/02

The Examiner, in his answer, argues that the added limitations do not sufficiently distinguish claim 13 from the surrendered claim. In support of this position the Examiner cites MPEP §1412.02, specifically Examples A and B, which the Examiner contends closely matches the present fact scenario.

MPEP §1412.02 is directed to the recapture of cancelled subject matter. Example A provides an example of proposed reissue claims have been broadened to omit a limitation that was originally argued in the original application to make the application claims allowable over a rejection. Example A is not directly applicable to the present fact scenario.

In the present case, claim 13 has been amended not just to eliminate limitations argued during original application prosecution, but to add additional limitations which render the claim distinct from the surrendered claim. Example A does not address a situation such as this, where other limitations are added to the reissue claim. Example A is limited solely to the situation where the argued language is removed from the reissue claim without additional limitations being provided. As noted, Example A covers only the situation where the applicant argues that claim, absent the omitted limitation, still defines over the prior art.

Example B of MPEP §1412.02 is directed to the situation where the omitted language of the reissue claim was specifically added during prosecution in the parent application. As with Example A, Example B deals solely with the situation where the only difference between the surrendered claim and the reissue claim is the omission of the previously added limitation. Again, Example B does not closely match the present fact scenario in that while the reissue claim omits a limitation from the originally presented claim, it also adds other limitations which distinguish the reissue claim from the surrendered claim.

Accordingly, contrary to the Examiner's position, neither Example A nor Example B of MPEP §1412.02 are applicable to the case.

However, MPEP §1412.02 does address the present situation. Under the Section entitled **'REISSUE CLAIMS ARE BROADER IN SCOPE IN SOME ASPECTS, BUT NARROWER IN OTHERS:'**, it is stated that:

If the broadening aspect of the reissue claim relates to subject matter previously surrendered, the examiner must determine whether the newly added narrowing limitation in the reissue claim modifies the claim such that the scope of the claim no longer results in recapture of the surrendered subject matter.

This is the exact point of contention in the present case. Appellant has argued strenuously that the limitations presented in the present reissue claims modifies the claim in such a manner that the scope of the claim no longer results in recapture of the surrendered subject matter, notwithstanding the fact that certain limitations are omitted from the reissue claims.

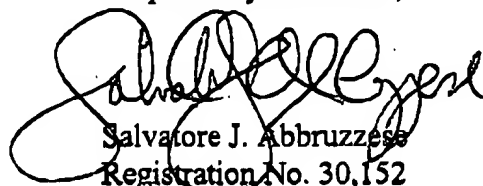
Therefore, the reissue claims of the present application do not constitute permissible recapture and that the Examiner's reference to certain sections of MPEP §1412.02 are misplaced.

The remaining arguments presented by the Examiner in the Answer are believed to be adequately addressed in Appellant's Brief.

Accordingly, in view of the arguments presented herewith and in view of the arguments presented in Appellant's Brief, reversal of the final rejection is respectfully requested.

Filed on even date herewith under separate cover is a request for oral hearing.

Respectfully submitted,



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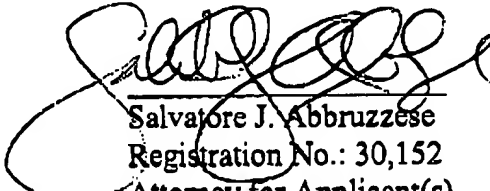
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Washington, DC 20231-0001

REQUEST FOR ORAL HEARING UNDER 37 CFR §1.194(b)

Sir:

Appellants hereby request an oral hearing of the Appeal for the above-referenced application. This Request is believed to be timely filed, in that the Examiner's Answer was mailed on March 13, 2002, and the term for filing the present Request therefore expires two-months from that mailing date, i.e., May 13, 2002. Enclosed please find the fee of \$280.00. Also, please charge any deficiency or credit any overpayment to Deposit Account No. 08-2461.

Respectfully submitted,


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DATE: May 16, 2002**FACSIMILE TRANSMISSION COVER SHEET**

TO: Dale Shaw/USSN: 09/391,762
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PROSTHESES

The U. S. Patent and Trademark Office date stamp will acknowledge receipt of the following:

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